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EXAMINER

MURPHY, J

ART UNIT

PAPER NUMBER

1646

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/491,577

Applicant(s)

CARLSON ET AL.

Examiner

Joseph F Murphy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 11-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: *Sequence Comparison A*.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-10, directed to SEQ ID NO: 31 in Paper No. 8, 4/25/2001 is acknowledged. The traversal is on the grounds that the groups of inventions are not independent. Applicant's attention is directed to MPEP 808.02 which states that "Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05 (c-i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) Separate classification thereof; (B) A separate status in the art when they are classifiable together; (C) A different field of search." As set forth in the Restriction requirement, Group I is classified in class 435, subclass 69.1; Group II is classified in class 530, subclass 350. The separate classification established for each Group demonstrates that each distinct Group has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Thus, the Restriction requirement is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claims 11-26 are withdrawn from further consideration by the Examiner pursuant to 37 CFR 1.142(b). Claims 1-10 are under consideration.

### ***Specification***

The title of the invention is not descriptive. Applicant should avoid the use of novel in the title, as patents are presumed to be novel and unobvious.

***Claim Objections***

Claims 3-10 are objected to because of the following informalities: They contain subject matter directed towards a non-elected invention. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. § 101 because they are drawn to an invention with no apparent or disclosed patentable utility. The instant application has provided a description of an isolated DNA encoding a protein and the protein encoded thereby. The instant application does not disclose the biological role of this protein or its significance. Applicant is directed to the Utility Examination Guidelines, Federal Register, Vol. 66, No. 4, pages 1092-1099, Friday January 5, 2001.

It is clear from the instant specification that the nucleic acid encoding the alleged *Drosophila* odorant receptor with the sequence as set forth in SEQ ID NO: 31 has been isolated because of its similarity to known nucleic acids encoding known proteins. However, it is commonly known in the art that sequence-to-function methods of assigning protein function are prone to errors (Doerks et al.1998). These errors can be due to sequence similarity of the query region to a region of the alleged similar protein that is not the active site, as well as homologs that did not have the same catalytic activity because active site residues of the characterized family were not conserved (Doerks et al. page 248, column 3, fourth and fifth paragraphs). Inaccurate use of sequence-to-function methods have led to significant function-annotation errors

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in the sequence databases (Doerks et al. page 250, column 1, third paragraph). After complete characterization, this protein may be found to have a patentable utility. This further characterization, however, is part of the act of invention and until it has been undertaken Applicant's claimed invention is incomplete. The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 USPQ 689 (Sup. Ct., 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anticancer activity was alleged to be potentially useful as an antitumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" to the chemical arts when this term is given its broadest interpretation. However, the court held that this broad interpretation was not the intended definition of "useful" as it appears in 35 USC § 101, which requires that an invention must have either an immediately obvious or fully disclosed "real world" utility. The court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

The instant claims are drawn to a nucleic acid encoding a polypeptide which has an as yet undetermined function or biological significance. Until some actual and specific significance can be attributed to the nucleic acid identified in the specification as SEQ ID NO: 31 the instant invention is incomplete. The nucleic acid of the instant invention is known to encode a polypeptide structurally analogous to proteins which are known in the art as *Drosophila* odorant receptors. However, it is known in the art that even single amino acid changes or differences in

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the amino acid sequence of a protein can have dramatic effects on the protein's function. For example, Mikayama et al. (1993) teaches that the human glycosylation-inhibiting factor (GIF) protein differs from human migration inhibitory factor (MIF) by a single amino acid residue (page 10056, Figure 1). Yet, despite the fact that these proteins are 90% identical at the amino acid level, GIF is unable to carry out the function of MIF, and MIF does not exhibit GIF bioactivity (page 10059, second column, third paragraph). It is also known in the art that a single amino acid change in a protein's sequence can drastically affect the structure of the protein and the architecture of an entire cell. Voet et al. (1990) teaches that a single Glu to Val substitution in the beta subunit of hemoglobin causes the hemoglobin molecules to associate with one another in such a manner that, in homozygous individuals, erythrocytes are altered from their normal discoid shape and assume the sickle shape characteristic of sickle-cell anemia, causing hemolytic anemia and blood flow blockages (pages 126-128, section 6-3A and page 230, column 2, first paragraph). In the absence of knowledge of the natural substrate or biological significance of this encoded protein, there is no immediately obvious patentable use for it. To employ a protein of the instant invention in the identification of substances which inhibit its activity is clearly to use it as the object of further research which has been determined by the courts to be a non-patentable utility. Since the instant specification does not disclose a "real world" use for the nucleic acid identified in the specification as SEQ ID NO: 31 then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 USC § 101 as being useful.

Claims 1-10 also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well

established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

***Claim Rejections - 35 USC § 112 first paragraph***

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid molecule encoding the polypeptide encoded by SEQ ID NO: 31, does not reasonably provide enablement for a nucleic acid molecule that encodes a fragment of the polypeptide encoded by SEQ ID NO: 31. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 1 and 9 are overly broad in the recitation of "fragment" since no guidance is provided as to which of the myriad of polypeptide species encompassed by the claim will retain the characteristics of the polypeptide encoded by SEQ ID NO: 31. In the specification (page 18, lines 24-28), Applicants disclose that variants of the polypeptide can be generated by deletion, addition, or alteration of the amino acids incorporated into the protein sequence, without disclosing any actual or prophetic examples on expected performance parameters of any of the possible muteins of the polypeptide encoded by SEQ ID NO: 31. However, as was discussed in the 35 USC § 101 rejection above, with reference to the mikayama et al. and Voet et al. references, it is known in the art that even single amino acid changes or differences in the amino acid sequence of a protein can have dramatic effects on the protein's function.

There is no guidance provided in the specification as to how one of ordinary skill in the art would generate a nucleic acid sequence encoding a polypeptide other than those exemplified

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in the specification. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. The factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. Given the breadth of claims 1-10 in light of the predictability of the art as determined by the number of working examples, the level of skill of the artisan, and the guidance provided in the instant specification and the prior art of record, it would require undue experimentation for one of ordinary skill in the art to make and use the claimed invention.

***Claim Rejections - 35 USC § 112 second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the term "sufficient stringency", which is a conditional term and renders the claim indefinite. Furthermore, some nucleic acids which might hybridize under conditions of



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moderate stringency, for example, would fail to hybridize under conditions of high stringency.

The metes and bounds of the claim thus cannot be ascertained. This rejection could be obviated by supplying specific conditions supported by the specification which Applicant considers to be "sufficient[ly] stringent". Claims 2-10 are rejected insofar as they depend on the recitation in claim 1 of "sufficient stringency".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-10 are rejected under 35 U.S.C. 102(a) as being anticipated by Celniker et al. (1998).

Celniker teaches a nucleic acid sequence that would hybridize under conditions to produce a clear signal, see Sequence Comparison A, attached. Furthermore, this nucleic acid sequence encodes a protein fragment of at least 6 amino acids in length. This nucleic acid was cloned into vectors and transformed into host cells for purposes of sequencing.

### ***Conclusion***

No claim is allowed.

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*Advisory Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245.

The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.  
Patent Examiner  
Art Unit 1646  
June 22, 2001

*Prema Mertz*  
**PREMA MERTZ**  
**PRIMARY EXAMINER**